

Appl. No. 10/849,282
Amendment dated July 25, 2007
Reply to Office Action of February 23, 2007

REMARKS

Reconsideration is respectfully requested in light of the amendments above and the remarks that follow.

Claims 1-9 are pending. Applicant has followed the suggestion the Examiner made during the July 23, 2007 telephonic interview and amended claims 1 and 5 to expressly present the limitation of the composition being "effective for treating inflammation." Because this limitation was already present in the preamble of the claims, this is a non-narrowing limitation. Support for amended claims 1 and 5 can be found in, for example, pages 3 and 8-11 of the specification as filed.

Claims 6-9 are withdrawn by the Examiner as directed to a non-elected invention pursuant to 37 C.F.R. § 1.142(b).

Rejections under 35 U.S.C. § 103

Claims 1-5 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent Number 5,696,105 to Hackler (herein, "Hackler"). Applicant respectfully traverses.

Munayyer teaches away from use of propylene glycol in an anti-inflammatory cream composition

Hackler expressly incorporates U.S. Patent Number 4,808,610 to Munayyer et al. (herein, "Munayyer") by reference by stating:

U.S. Pat No. 4,808,610 discloses a cream formulation including mometasone furoate.

The above three patents are hereby incorporated by reference ... [Column 2, lines 9-12 of Hackler]

Therefore, Munayyer must be considered, as part of the text of cited Hackler.

Munayyer states:

"propylene glycol based cream formulations [of mometasone furoate] did not possess the necessary [anti-inflammatory] efficacy." [Column 1, lines 22-24 of Munayyer]

At the time the invention of the instant application was made, one of ordinary skill in the art would have been aware of Munayyer. The compositions of the instant independent claims 1 and 5 are limited by the property of being "effective for treating inflammation." One of ordinary skill in the art developing a composition of mometasone furoate having the property of being "effective for treating inflammation" would have been discouraged by the text of Munayyer from basing the composition on propylene glycol.

Applicant appreciates the Examiner having recognized during the July 23 telephonic interview that, because Munayyer directly teaches away from including propylene glycol in an anti-inflammatory mometasone furoate composition, one of ordinary skill in the art would not have substituted propylene glycol in the cream formulation of Hackler at the time of invention for the instant application. Applicant therefore respectfully requests that the rejection of claim 1, claims 2-4 dependent therefrom, and claim 5 be withdrawn.

No reasonable expectation of success with propylene glycol

Munayyer states that "propylene glycol based cream formulations [of mometasone furoate] did not possess the necessary [anti-inflammatory] efficacy." Therefore, at the time of invention for the instant application, one of ordinary skill in the art had no reasonable expectation of success in developing a composition based on propylene glycol that had the characteristic of being "effective for treating inflammation," as required by the instant independent claims 1 and 5. Therefore, Applicant respectfully requests that the rejection of claim 1, claims 2-4 dependent therefrom, and claim 5 be withdrawn.

Hackler is nonanalogous art

In order for the Examiner to rely on a reference in making a rejection under 35 U.S.C. § 103, at least one prong of the following two-prong test must be satisfied:

"the reference must either [1] be in the field of applicant's endeavor or, if not, then [2] be reasonably pertinent to the particular problem with which the inventor was concerned." [MPEP § 2141.01(a)]

Independent claims 1 and 5 of the instant application teach a "topical water-in-oil pharmaceutical cream composition" with the property of being "effective for treating inflammation." Inflammation is the body's own reaction of the body to a stimulus, for example, of biological or chemical origin.

By contrast, Hackler teaches a "composition treating nail fungus or onychomycosis." See Abstract of Hackler; also see column 4, lines 3-4 and claims 1 and 15 of Hackler. A fungal infection is an invasion of the body by a foreign microorganism, a fungus. Thus, Hackler is not in the field of the "applicant's endeavor" of treating inflammation, and the first prong [1] of the two-prong test is not satisfied.

Claims 1 and 5 of the instant application indicate that the "particular problem with which the inventor was concerned" was development of a "cream composition ... effective for treating inflammation."

By contrast, Hackler is concerned with developing a "composition [for] treating nail fungus or onychomycosis." Thus, the material in Hackler is not "reasonably pertinent to the particular problem with which the inventor was concerned," and the second prong [2] of the two-prong test is not satisfied.

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Because Hackler is neither within the field of endeavor of the instant Applicant nor reasonably pertinent to the particular problem with which the inventor associated with the instant application was concerned, Hackler is non-analogous to the instant application. Thus, Hackler cannot be relied upon as a reference in rejecting claims of the instant application under 35 U.S.C. § 103(a). Therefore, Applicant respectfully requests that the rejection of claim 1, claims 2-4 dependent therefrom, and claim 5 be withdrawn.

In summary, because Munayyer as incorporated by reference into Hackler teaches away from a propylene glycol based mometasone furoate cream composition effective for treating inflammation, one of ordinary skill in the art had no reasonable expectation of success in substituting propylene glycol in a formulation of Hackler to make a cream composition effective for treating inflammation, and Hackler is non-analogous art, there is no *prima facie* case for obviousness of claims 1-5 of the instant application. Therefore, Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) of claims 1-5 be reversed and claims 1-5 be deemed patentable.

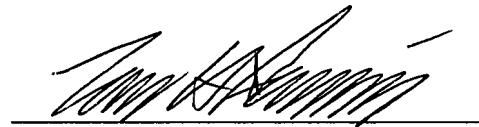
All of the stated grounds of rejection have been rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

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A Notice of Allowance for claims 1-5 is respectfully requested.

Respectfully submitted,



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